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10/706,871

11/12/2003

Nicholas Stamos

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

PAPER NUMBER

3609

MAIL DATE

DELIVERY MODE

05/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## Office Action Summary

Application No.

10/706,871

Applicant(s)

STAMOS ET AL.

Examiner

Joshua Murdough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/12/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/26/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 5C shows “(other protocols???)” and “??? (TCPIPinbound, TCPIPOutbound)”. These sections are vague and indefinite, and therefore are objected to. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no mention of how the vetoing of violation predicates by other violation predicates is to be used or implemented within the specification of the invention. As disclosed, one of ordinary skill in the art would not be able to make and use the invention without undue experimentation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:



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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12 through 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. These claims are for a system, which is understood to be a machine or manufacture. Within the body of the claims, no physical components are described. Rather, software modules only appear to be recited.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12 through 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims refer to a system and/or apparatus but there is no mention of a physical component comprised within. Simply reciting that the claimed invention is a system or apparatus is not sufficient to classify it as either machine or manufacture, since no machine or manufacture elements are recited. Rather, only disembodied software is recited, which is per se nonstatutory.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:



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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 through 3, 5, 8, 11 - 14, 16, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Shear (US 20010042043).

10. As to claim 1, Shear shows the ability to control access to digital assets (Paragraph 0184); aggregate atomic events (Paragraph 0188); assert policy violation predicate, typically this would be restricting access or notifying either the user or someone of authority, this is shown through the “security, metering, and usage administration capabilities” (Paragraph 0193), wherein, security and administration capabilities would commonly be understood to include access and notification functionalities; and the ability to sense atomic events (Paragraph 0211).

11. As to claim 2, Shear also shows the policy violation predicate being from the kernel (Paragraph 0182).

12. As to claim 3, Shear also shows the ability to restrict access through usage controls and usage administration capabilities (Paragraph 0197).

13. As to claim 5, Shear also shows that the policy violation predicate can be triggered according to the timing of events (Paragraph 0168). In the example given, the first copy is allowed, but after that first copy, the predicate is triggered if another copy is attempted.

14. As to claim 12, Shear shows a means to control access to digital assets (Paragraph 0184), aggregate atomic events (Paragraph 0188), assert policy violation predicate (Paragraph 0193), and the ability to sense atomic events (Paragraph 0211).

15. As to claim 13, Shear also shows the policy violation predicate being from the kernel (Paragraph 0182).



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16. As to claim 16, Shear also shows that the policy violation predicate can be triggered according to the timing of events (Paragraph 0168). In the example given, the first copy is allowed, but after that first copy, the predicate is triggered if another copy is attempted.

17. As to claims 8 and 19, Shear further shows that the security measures can be assigned based on the content, and thus, independent of the application (Paragraph 0055).

18. As to claims 11, and 22, Shear further shows that a particular file can be identified in an access event as referenced by the controls in combination with content usage information being transmitted to a responsible party (Paragraph 0197).

19. As to claim 14, Shear further shows inherently that the type of policy that was violated could be determined through use of the above mentioned usage information (Paragraph 0197).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 6, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear.

22. As to claims 6, 17, and 20, Shear shows all of the elements except for the ability of the user to document their reason for the policy violation. The Examiner takes official notice that it is notoriously old and well known in the art to document the reason for an access. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the



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invention of Shear to incorporate this functionality. The ability to document the reason at the time of the occurrence would provide for a record of what was done and why, saving the effort of finding the appropriate person to notify.

23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shear in view of Danieli (US Patent 6510513).

24. As to claim 9, Shear shows all of the elements except for the notification of the user that they have violated a policy. Danieli shows "alerting a user of the client computer of the inappropriate use" (Claim 14) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shear with the teachings of Danieli to make it known to the user that there was a violation, because the notification allows the user to know they have done something the system believes they should not, enabling them to justify their actions to a responsible party and possibly get the policy changed, if their actions were justified.

25. Claims 4, 7, 10, 15, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear in view of McCarty (US Patent 5666411).

26. As to claims 4 and 15, Shear shows all of the elements except for the use of an intercept. McCarty teaches the use of an intercept in a digital asset control system (Column 14, Lines 4-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shear to use the intercepts as taught by McCarty, because intercepts take precedence over other commands being executed on the system, thus enabling the policy violation predicates to restrict the access to a file before the action with that file is finished.

27. As to claims 7 and 18, Shear shows all of the elements except for the ability for policy violation predicates to veto each other. McCarty teaches the use of an intercept in a digital asset



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control system (Column 14, Lines 4-7). It would have been obvious to one of ordinary skill in the art at the time of the invention that the use of interrupts enables the preemption of some predicates by predicates of higher status. Thus, it would also have been obvious to incorporate this preemption into the invention of Shear, as it would allow for the strongest actions to execute more quickly, providing better security on the system.

28. As to claims 10 and 21, Shear shows all of the elements except for the execution in real time. McCarty states that the system should operate in real time (Abstract, lines 4-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shear with the real time teachings of McCarty, because real time execution allows for a quicker response time, and when the response is to restrict an action, the sooner it is done, the more secure the data can be.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m..

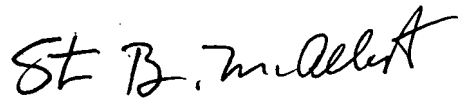
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven McAllister can be reached on (571) 272-6785. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough

A handwritten signature in black ink, appearing to read "Steve McAllister".

STEVE MCALLISTER  
SUPERVISORY PATENT EXAMINER